

Appl. No. : 10/029,109
Filed : October 19, 2001

- REMARKS -

Applicants gratefully acknowledge the Office Action mailed November 8, 2002 in the above-referenced application. In the Office Action, the Examiner recognized that Claims 1-14 and 37 had been cancelled pursuant to a Restriction Requirement; Applicants retain the right to file divisional applications to pursue these claims. Claims 15-36 and 38 were then pending.

With regard to the merits of the pending claims, the Examiner recognized that the Specification enabled, for example, Claim 23 but *rejected* Claims 15-22, 25-26, 28-29, 31-32, 34 and 36 under 35 U.S.C. § 112, first paragraph for (i) lack of adequate written description and (ii) lack of "enablement for the exceptionally broad claimed invention." The Examiner *objected* to Claim 24 under 37 C.F.R. § 1.75 "as being a substantial duplicate of Claim 23," on the ground that these claims "are so close in content that they both cover the same thing, despite a slight difference in wording." The Examiner, in closing, acknowledged that Claims 23, 24, 27, 30, 33 and 35 are drawn to allowable subject matter.

To expedite prosecution of the above-referenced application, Applicants have cancelled rejected Claims 15-22, 25-26, 28-29, 31-32, 34, 36 and 38. Applicants cancel these claims without acknowledging the correctness of the Examiner's distinct rejections under 35 U.S.C. § 112, first paragraph, and do so with the intention of pursuing the subject matter of the rejected claims in a continuing application. Because the Examiner has acknowledged that Claims 23, 24, 27, 30, 33 and 35 are drawn to allowable subject matter, Applicants seek to bring these claims to issue in the present application.

With regard to Claim 24, which stands "objected to" under 37 C.F.R. § 1.75, Applicants direct the Examiner's attention to line 1 of Claim 23 and line 1 of Claim 24, and to paragraphs 0047 and 0048, on pages 13 and 14 of Applicants' Specification, as filed. While Claim 23 recites a method of reducing the "number of wakings after sleep onset," Claim 24 recites a method of reducing the "length of wakings after sleep onset." As explained in, for example, the above-cited portion of Applicants' Specification, these *distinct* parameters relate to *distinct* indications for which the recited method is effective; one parameter (indication) may be particularly relevant to one class of patients, while the other parameter (indication) may be particularly relevant to another, distinct class of patients. Stated otherwise, an infringer might

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target one class of patients and promote its product as being effective *only* in reducing the number of wakings or, alternatively, in reducing the length of wakings. Each distinct type of promotion would be differently situated with respect to Claims 23 and 24. See 35 U.S.C. § 271(b). Therefore, because Claims 23 and 24 do not necessarily "cover the same thing," Applicants respectfully request reconsideration and removal to the objection to Claim 24.

CONCLUSION

Applicants respectfully assert that all currently pending claims, i.e., Claims 23, 24, 27, 30, 33 and 35, are fully in condition for allowance. If any outstanding matter remains that would forestall the issuance of these claims, Applicants urge the Examiner to contact the undersigned attorney.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 1, 2003

[Signature]

By: *[Signature]*

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